APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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3693	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/705,334	ZUBIZARRETA, MIGUEL A.
	Examiner	Art Unit	
	JAMES A. VEZERIS	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Detailed Action

Response to Applicant's Arguments

1.   Applicant's arguments with respect to claims 1 and 4-27 have been considered

but are moot in view of the new ground(s) of rejection. Examiner notes that the

arguments stem from amendments made to the claims and are contemplated in the

rejection below.

Claim Rejections- 35 U.S.C. 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

2.   Claims 1, 3-14, 15-16, and 27 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter.

3.   Regarding Claims 1, 3-14, and 27, a computer-implemented method is claimed

with no physical support shown in the body of the claims. As such the claims are being

construed to be computer code per se. Applicant is advised to add computer structure

to the body of the claims. See in re Bilski.

4.   Regarding claims 15 and 16, a software system stored on one or more computer

readable media is claimed. As such, computer code per se is being claimed, not the

computer readable media. Applicant is advised to change the preamable of the claims

to be directed towards the computer readable media.

Claim Rejections- 35 U.S.C. 112 2nd Paragraph

5.   Claims 17 and 18 are rejected under 112 2nd Paragraph for being indefinite.

Because general purpose computers can be programmed to perform very different

tasks in very different ways, simply disclosing a computer as the structure designated to

perform a particular function does not limit the scope of the claim to the corresponding

structure, material acts that perform the function, as required by section 12, paragraph

6.

Claim Rejections- 35 U.S.C. 103(a)

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1,4-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over "A

Shift In Check Clearing And Settlement Technology" in view of US Patent 5,930,778 to

Geer. (Hereinafter "Geer") in further view of US Patent 7,200,255 to Jones et al.

(Hereinafter "Jones")

Regarding Claim 1, 15, 17, 19, and 27:

Shift teaches a computer-implemented method for the sorting of check files and

facilitating the direct distribution of the check files to multiple endpoints, comprising:

Receiving an unsorted check file comprising check images and related check data. (See section titled "Cutting the Check")

Processing the unsorted check files to create sorted check images and related check data in separate sorted check files. (See section titled "Cutting the Check")

Associating a sorted check file with a corresponding endpoint. (See section titled "Cutting the Check")

Directly distributing the sorted check files to their corresponding endpoints for presentment for payment from the image and related data. (See section titled "Cutting the Check")

Shift fails to teach the receiving, processing, associating, and directly distributing processes are performed by a bank that captures check images of checks the bank has accepter for deposit; and

wherein a data structure stored on computer-readable storage medium is used to maintain sorting information during said processing of the unsorted check file, wherein the data structure includes and ABA number field, an account number field, an endpoint number field, and a primary ABA indicator field;

Geer teaches the receiving, processing, associating, and directly distributing processes are performed by a bank that captures check images of checks the bank has accepter for deposit. (See figure 1, col 7)

It would be obvious to combine Geer and Shift. There is motivation to do so because, the outsourcing of the work from the bank to a third party potentially saves time and money for the bank.

Jones teaches wherein a data structure stored on computer-readable storage medium is used to maintain sorting information during said processing of the unsorted check file, wherein the data structure includes and ABA number field, an account number field, an endpoint number field, and a primary ABA indicator field; (See Column 18 Lines 1-14)

It would be obvious to one skilled in the art at the time of the invention to include in the system taught by shift the ability to store a data structure on a computer-readable storage medium as taught in Jones since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 15, 17, and 19 are rejected for analogous reasoning.

Regarding Claim 4:

Shift further teaches the unsorted check file is provided by an entity that has received payment checks and has captured the check images in the check image file. (See section titled "Cutting the Check")

Regarding Claim 5:

Shift further teaches the endpoints correspond to one or more banks. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

Regarding Claim 6:

Shift further teaches:

Associating a primary endpoint with a plurality of endpoints. (See section titled "Cutting the Check")

Directly distributing the sorted check files according to the primary endpoint. (See section titled "Cutting the Check")

Regarding Claim 7:

Shift further teaches:

A first sorting of the check images and related check image data according to the primary endpoints. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

A second sorting of the check images and related check image data according to the plurality of endpoints associated with the primary endpoint. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

Examiner also notes a first sorting and second sorting are taught in Geer as can be seen in figure 1. Checks go to a check payee account as well as an archive of electronic images.

Regarding Claim 8:

Shift further teaches the endpoints are ABA numbers. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing" and second paragraph of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

Regarding Claim 9:

Shift further teaches the directly distributing process comprises a timed batch

transmission of sorted check files to an electronic address associated with an endpoint.

(See section titled "Cutting the Check" and last paragraph of section titled "Just as

Electronic Check Volume is Increasing") Examiner notes the sending of information at

any time can constitute a timed batch.

Regarding Claim 10:

Shift further teaches the sorted check files conform to one or more electronic

payment standards. (See section titled "Cutting the Check" and last paragraph of

section titled "Just as Electronic Check Volume is Increasing")

Regarding Claim 11:

The method of Claim 1 further comprising distributing one or more sorted check

files to a Federal Reserve Bank. (See section titled "Cutting the Check" and last

paragraph of section titled "Just as Electronic Check Volume is Increasing")

Regarding Claim 12:

Shift further teaches storing the cumulative value of the checks transmitted in a

sorted check file and the endpoint to which the sorted check file is transmitted in a

reconciliation database. (See section titled "Cutting the Check" and last paragraph of

section titled "Just as Electronic Check Volume is Increasing" and third paragraph of

section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

Regarding Claim 13:

Shift further teaches storing the cumulative value of the checks received in the

unsorted check file and an endpoint from which the unsorted check file is received in the

reconciliation database. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

Regarding Claim 14:

Shift further teaches generating a report that reconciles a clearing of outbound checks versus inbound checks for an endpoint. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing" and second and third paragraphs of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

Regarding Claim 16:

Shift further teaches instructions operable to cause one or more computers upon execution by the one or more computers to directly distribute the sorted check files to their corresponding endpoint for presentment for payment from the image and related data. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

Regarding Claim 18:

Shift further teaches means for causing one or more computers to perform the operation of directly distributing the sorted check files to their corresponding endpoints for presentment for payment from the image and related data. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

Regarding Claim 20:

Shift further teaches the sorting database comprises a data record structure stored in a computer readable medium, the data structure comprising an ABA number

field, an account number field, an endpoint number field, and a primary ABA field. (See

Last paragraph of section titled "Just as Electronic Check Volume is Increasing" and

second paragraph of section titled "Leveraging Prime Pass Image Capture for Check

Image Exchange")

Regarding Claim 21:

Shift further teaches the ABA number field in a first data record structure may be

associated with a primary ABA field in a second data record structure. (See Last

paragraph of section titled "Just as Electronic Check Volume is Increasing" and second

paragraph of section titled "Leveraging Prime Pass Image Capture for Check Image

Exchange")

Regarding Claim 22:

Shift further teaches:

a direct distribution computer system comprising a processing system and a

memory system, the memory system storing processing instructions operable to cause

the processing system to receive the separate sorted check files and directly distribute

the separate sorted check files to institutions associated with the corresponding

endpoints of the separate sorted check files. (See Last paragraph of section titled "Just

as Electronic Check Volume is Increasing")

Regarding Claim 23:

Shift further teaches the sorting database comprises a data record structure

stored in a computer readable medium, the data structure comprising an ABA number

field, an account number field, an endpoint number field, and a primary ABA field, and

wherein the ABA number field in a first data record structure may be associated with a

primary ABA field in a second data record structure. (See Last paragraph of section

titled "Just as Electronic Check Volume is Increasing" and second paragraph of section

titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

Regarding Claim 24:

Shift further teaches the direct distribution computer system is operable to

directly distribute the separate sorted check files to institutions associated with the

primary ABA field. (See Last paragraph of section titled "Just as Electronic Check

Volume is Increasing" and second paragraph of section titled "Leveraging Prime Pass

Image Capture for Check Image Exchange" and second and third paragraphs of section

titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

Regarding Claim 25:

Shift further teaches the sorting computer system and the direct distribution

computer system comprise a single computer system. (See Last paragraph of section

titled "Just as Electronic Check Volume is Increasing")

Regarding Claim 26:

Shift further teaches the sorting computer system and the direct distribution

computer system comprise a plurality of computer systems in communication over a

computer network. (See Last paragraph of section titled "Just as Electronic Check

Volume is Increasing" and second and third paragraphs of section titled "Leveraging

Prime Pass Image Capture for Check Image Exchange")

Other Potential Art

4.   US Patent 6,996,263 to Jones et al. "Network Interconnected Financial

Document Processing Devices" filed Jan. 9, 2002.

5.   Public Law 108-100, "Check Clearing for the 21st Century Act" found @

"http://frwebgate.access.gpo.gov/cgi-

bin/getdoc.cgi?dbname=108_cong_public_laws&docid=f:publ100.108.pdf"

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JAMES A. VEZERIS whose telephone number is

(571)270-1580. The examiner can normally be reached on Monday-alt. Fridays

7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Kramer can be reached on 571-272-6803. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/   /JAMES A VEZERIS/
Supervisory Patent Examiner, Art Unit 3693   Examiner, Art Unit 3693

2/16/2009